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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,062	11/19/2001	Reinhard Plaschka	PLAS3002/JEK	8599

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,062

Applicant(s)

PLASCHKA ET AL.

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,9,14,16,17,19,21,22,27,31 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 and 42-47 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9,14,16,17,21,22 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/29/04 6/30/04</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit:

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. After further review and consideration of the pending claims, the examiner has decided to withdraw the finality of the previous office action and submit a new office action with an new ground of rejections.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. In regards to Claim 3, it is not understood what is meant by the phrase “in register”. Does applicant mean that second printed layer is “in register” in a particular location (as in adjacent, parallel or superimposed), and if so how is “in register”?

3. In regards to claim 17, it is not understood what is meant by “a particle with suitable size”? Applicant must explain what the particle is “suitable” for?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, ~~3~~, 5, 14, 19, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaule et al (6,036,232).

Art Unit:

Kaule et al discloses in Fig. 1-3 and 6, a document of value comprising a security element (2 and 3) having at least one optically variable material (2) that conveys different color effects at different viewing angles (Col. 4, lines 24-27); and at least one machine readable feature substance (3, as stated in Col. 3, lines 45-56) that is in the form of a coded or alphanumeric information (Col. 5, lines 37-40); wherein the security element comprises a printed image having a first printed layer (seen in Fig. 6) containing the features (Col. 2, lines 62 and 63, and Col. 5, lines 50-67), and the optically variable material disposed over the printed layer (Fig. 6); a second printed layer (5, as shown in Fig. 3, and in Col. 5, lines 7-14) containing no feature substance that is disposed in register with the first printed layer and shows the same visual appearance as the first printed layer; wherein the security element has liquid-crystal materials with different polarization properties (Col. 6, lines 17-32) wherein light with a certain polarization is reflected; and wherein the optically variable material can be a liquid-crystal material (Col. 6, lines 43-55); wherein the machine readable material is a material luminescing outside a visible spectral region (Col. 3, lines 8-15), or an IR-absorbent material (Col. 3, lines 60-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule et al (6,036,232).

Kaule et al discloses a document of value comprising all the elements as claimed in Claim 1, and as set forth above. However, Kaule et al does not disclose: wherein the first printed layer has a dark color.

In regards to Claim 3, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. Therefore, it would have been obvious to the first printed matter any desired color different than the substrate, since applicant has not disclosed the criticality of having a dark color in the first layer, and invention would function equally as well if the first layer had any substrate contrasting color.

6. Claims 9, 16, 17, 22 and 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule et al (6,036,232) in view of Braun et al (6,183,018).

Kaule et al discloses a document of value comprising all the elements as claimed in Claim 1, and as set forth above. However, Kaule et al does not disclose: wherein the security element is disposed on a plastic foil; wherein the optically variable material is an interference layer material;

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and is selected from the group consisting of a pigment and a particle with suitable size and shape factor; and a multilayer transfer material.

Braun et al discloses a document having an optically variable material which can be comprised of an interference layer and a pigment (Col. 5, lines 54-67); and wherein the security element is a multilayer transfer element which can be initially placed on a foil in whose layer structure the optically variable material and feature substance are disposed (Col. 6, lines 1-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kaule et al's document with an optically variable material comprised of an interference layer, or a pigment as taught by Braun et al as alternative optically variable elements to attain particular effects.

In regards to **Claim 17**, it would have been an obvious matter of design choice to make the different portions of the optically variable material particle of whatever shape or size was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. Therefore, it would have been obvious to construct the optically variable material particle of whatever form or size is desired by the end user, since applicant has not disclosed that a particular shape and size is critical to the invention, and invention would function equally as well with any particle shape or size.

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Allowable Subject Matter

7. Claims 31, 42-47 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record disclose multilayer transfer material and plastic pellets comprising optically variable material that conveys different color effects at different viewing angles and one machine readable feature substance that does not impair a visually visible optically variable effect of the optically variable material, wherein the optically variable material and the feature substance are disposed in one layer and the layer being present in the form of information; and including all of the other limitations of the independent claims.

Response to Arguments

9. Applicant's arguments filed on July 29, 2004 have been fully considered but they are not persuasive.

After further review and consideration of the claims, the examiner has withdrawn the previous final office action and has issued a new grounds of rejection. Kaule et al and Braun et al are used to disclose a document having a security element as claimed by applicant.

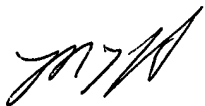
Art Unit:

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Abraham, Knight et al, Ojster, Kaule, Solmsdorf, Braun et al ('509), Bohm et al, Bratchley et al, Keller et al, Tompkin et al, Kaule et al ('047), Edwards, and Wolpert et al disclose similar documents having security elements.

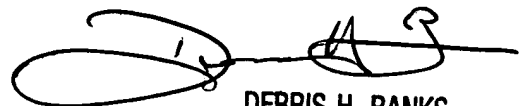
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Derris Banks, can be reached on (571) 272-4419. The fax number for TC 3700 is (703)-872-9306.



MTH

April 21, 2005



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
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